

Docket No. 1293.1900

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Kil-soo JUNG et al.

Application No. 10/612,415

Group Art Unit: 2178

Confirmation No. 3598

Filed: July 3, 2003

Examiner: David Faber

For: METHOD TO DISPLAY A MARK-UP DOCUMENT ACCORDING TO A PARENTAL LEVEL, METHOD AND APPARATUS TO REPRODUCE THE MARK-UP DOCUMENT IN AN INTERACTIVE MODE, AND A DATA STORAGE MEDIUM THEREFOR

REQUEST FOR CORRECTED NOTICE OF ALLOWABILITY AND
CORRECTED EXAMINER'S AMENDMENT

Mail Stop Issue Fee
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is in response to the Notice of Allowance of October 7, 2008. The issue fee and the publication fee have not yet been paid.

Request for Corrected Notice of Allowability and Corrected Examiner's Amendment

Item 2 on page 1 (the form PTOL-37) of the Notice of Allowability attached to the Notice of Allowance of October 7, 2008, correctly indicates that claims 17-20, 22, 50, and 52-56 have been allowed. Also, the Index of Claims dated October 7, 2008, in the image file wrapper of the application correctly indicates that claims 17-20, 22, 50, and 52-56 have been allowed. However, the Examiner's Amendment on page 2 of the Notice of Allowability incorrectly indicates that claims 1-4, 6-16, 22, 25-27, 34, 35, 37-45, 47-49, 57, and 58, which include allowed claim 22, have been canceled as allegedly authorized by the undersigned attorney, Randall S. Svhla, during a telephone interview conducted on September 23, 2008. However, the attorney did not

authorize the Examiner to cancel claim 22 during the telephone interview of September 23, 2008, as discussed in greater detail below.

Accordingly, it is respectfully requested that the Examiner issue a corrected Notice of Allowability and a corrected Examiner's Amendment indicating that claims 17-20, 22, 50, and 52-56 have been allowed, and that claims 1-4, 6-16, 25-27, 34, 35, 37-45, 47-49, 57, and 58 have been canceled by Examiner's Amendment to make it clear on the record that claim 22 has in fact been allowed.

Applicants' Statement of Substance of Interview

On September 22, 2008, Examiner David Faber called the undersigned attorney, Randall S. Svhla, and stated that he had decided to withdraw the requirement for an election of species set forth in the Office Action of May 30, 2008, issued by the previous Examiner, William L. Bashore, and that he would allow the application with method claims 17-20, 22, 50, and 52-56 if the applicants would agree to cancel medium claims 1-4 and 6-16 and apparatus claims 25-27, 34, 35, 37-45, 47-49, 57, and 58. The Examiner stated that the medium and apparatus claims are not allowable because, in his opinion, these claims are still nonstatutory under 35 USC 101, notwithstanding the amendments to these claims in the Amendment of November 6, 2007, and the arguments presented on pages 25 and 26 of the Amendment of November 6, 2007.

The attorney stated that it is the applicants' position that the medium and apparatus claims are in fact statutory under 35 USC 101, but stated that he would forward the Examiner's proposal to cancel the method and apparatus claims to place the application in condition for allowance with the method claims to the applicants for their review.

On September 23, 2008, the attorney called the Examiner and stated that the applicants had approved the Examiner's proposal, and the attorney authorized the Examiner to cancel medium claims 1-4 and 6-16 and apparatus claims 25-27, 34, 35, 37-45, 47-49, 57, and 58 to place the application with method claims 17-20, 22, 50, and 52-56. The attorney did not authorize the Examiner to cancel method claim 20, as the Examiner has done in the Examiner's Amendment on page 2 of the Notice of Allowability.

Request for Consideration of Reference Cited in Information Disclosure Statement of December 12, 2005

The Notice of Allowability includes a copy of the List of References Cited by Applicant from the Information Disclosure Statement of December 12, 2005, with a line drawn through the listing of the European Search Report (reference AM) to indicate that this reference has not been considered and a notation "no page listings" on the listing. On page 3 of the Notice of Allowability, the Examiner states as follows:

The information disclosure statement filed 12 December 2005 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because reference AM fails to list the document's pertinent pages. It has been placed in the application file, but the information referred to therein has not been considered as to the merits.

Title 37 CFR 1.98(b)(5) states as follows:

Each publication listed in an information disclosure statement must be identified by publisher, author (if any), title, relevant pages of the publication, date, and place of publication.

MPEP 609.04(a) states as follows in pertinent part on MPEP pages 600-151 and 600-152.

Each publication must be identified by publisher, author (if any), title, relevant pages of the publication, and date and place of publication. The date of publication supplied must include at least the month and year of publication, except that the year of publication (without the month) will be accepted if the applicant points out in the information disclosure statement that the year of publication is sufficiently earlier than the effective U.S. filing date and any foreign priority date so that the particular month of publication is not in issue. The place of publication refers to the name of the journal, magazine, or other publication in which the information being submitted was published.

However, it is submitted that the "relevant pages of the publication" must be listed only when part of a publication is being cited, such as when a journal article or a portion of a textbook is being cited. It is submitted that it is not necessary to list the "relevant pages of the publication" when an entire publication is being cited, as is the case with the European Search Report (reference AM) cited in the Information Disclosure Statement of December 12, 2005, which has

only three pages, none of which have page numbers. It is submitted that it is readily apparent that the entire European Search Report is being cited.

Accordingly, it is respectfully requested that the Examiner provide another copy of the List of References Cited by Applicant from the Information Disclosure Statement of December 12, 2005, marked to indicate that the European Search Report has been considered with the corrected Notice of Allowability requested above.

Conclusion

Should any questions remain unresolved, the Examiner is requested to telephone the undersigned attorney.

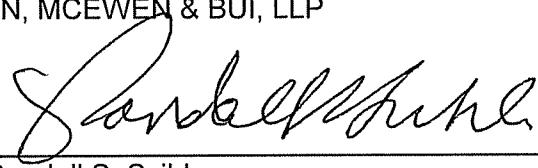
If there are any additional fees associated with the filing of this paper, please charge the same to our Deposit Account No. 503333.

Respectfully submitted,

STEIN, MCEWEN & BUI, LLP

Date: 11/12/08

By:


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